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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,562	03/29/2001	Gilbert Bloch	82017-3700	4962

7590 10/07/2003

WINSTON & STRAWN  
200 Park Avenue  
New York, NY 10166-4193

EXAMINER

ZIRKER, DANIEL R

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 10/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO. <i>Ag</i>
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EXAMINER
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DATE MAILED:

Below is a communication from the EXAMINER in charge of this application  
COMMISSIONER OF PATENTS AND TRADEMARKS

**ADVISORY ACTION**

**THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.**

Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check only a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 707.07(f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- a) ☒ they raise new issues that would require further consideration and/or search. (see NOTE below);
  - b) ☐ they raise the issue of new matter. (see NOTE below);
  - c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE:

*See attached NOTE.*

4. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_
5. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *see attached NOTE.*
7. ☒ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
- Claim(s) allowed: *None*
- Claim(s) objected to: \_\_\_\_\_
- Claim(s) rejected: *16-30*
- Claim(s) withdrawn from consideration: \_\_\_\_\_
9. ☐ The proposed drawing correction filed on \_\_\_\_\_ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). *0930*
11. ☐ Other: \_\_\_\_\_

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1300-  
1700

*Daniel Zinker*

NOTE

1. The Examiner initially notes that applicant has clearly broadened his claims by responding to a 35 U.S.C. § 112 second paragraph rejection by expanding the previously claimed "pressure sensitive adhesive coating" to just an "adhesive coating". Although it is possible that all adhesives would be so suitable, this clearly constitutes a broadening of the claim language and as such would clearly constitute a new issue. Applicant argues (Response, page 4, third complete paragraph) that the present application was "refiled to pursue the laminates regardless of the use of specific type of adhesive that is selected for final use", but the prosecution history and his chosen claim language has not set forth this parameter.

2. The Examiner further notes that applicant has made several arguments that do not appear to be reflected in his claim language. In the Response, page 7, bottom two paragraphs, applicant strenuously argues that the Williams patents are each silent on the particular type of adhesive, which he claims must be a "water based adhesive". While it appears that it is possible that the utilization of such water based adhesives are encompassed by applicant's "cold lamination" technique, this has not been previously clearly set forth on the record. Additionally, at page 8, first complete paragraph, applicant argues that utilizing a corona discharge treatment immediately

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prior to the application of the adhesive is another distinguishing characteristic of the claimed invention. However, applicant's claims except for the presence of the "cold lamination" technique do not appear to be product-by-process in nature, and even if this is so this limitation has not been set forth on the record to date to the Examiner's satisfaction. Additionally, it is further respectfully submitted that corona discharge techniques are typically utilized before application of a desired adhesive layer on a film. Finally, with respect to applicant's remarks concerning the Ono et al. patent (Response, page 8, bottom paragraph), the Examiner initially notes that this patent appears to have inadvertently been mislabeled on applicant's IDS in both this, <sup>and</sup> it is also believed, in the parent applications. As such, the Examiner has set forth the correct numbering of the reference on a suitable Form 892. With respect to the disclosure of the Ono et al. reference, the Examiner again notes that column 3, lines 1-21 which refers primarily to the presence of the various outer adhesive layers is what has been relied upon during the prosecution history. Thus, applicant's arguments directed to the various processing of the fabric base and treated film is simply not seen as particularly pertinent.

3. Finally, the Examiner notes that the Declaration of co-inventor Finestone has also not been timely presented and so it has not been entered into the application file. Although some

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of its comments, e.g. paragraph No. 4, do not appear to totally reflect applicant's chosen claim language, the Examiner does note that were this Declaration to be timely presented in a continuing application its presence might prove promising to applicant.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

September 30, 2003